

Remarks

Claims 8-20 are now pending in this application. Claims 8, 11-16, and 18-20 stand rejected. Claims 9, 10 and 17 have been withdrawn. Claims 1-7 have been canceled.

The rejection of Claims 8, 11-14, 16, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Joecks et al (U.S. Patent No. 5,319,179) (“Joecks”) is respectfully traversed.

Joecks describes a protective-gas container (1) including a displaceable glass plate (22), a back wall, a front wall, opposing side walls, a bottom wall and a base plate (4) that extends across the bottom wall such that the container is divided into an upper working space (28) and a lower space that contains a network of gas supplying conduits and steel wool (3). A workpiece (7) e.g., a turbine blade, to be welded is secured within the upper workspace (28) such that the portion of the workpiece to be welded is positioned in a welding area (16) located inside the container (1) and adjacent a TIG welding burner/electrode (20).

Notably, Joecks does not describe nor suggest an enclosure received within a heating chamber of a SWET box, wherein the enclosure includes a stepped portion including a dividing wall that defines a welding chamber therein. Rather, Joecks describes a protective gas container (1) that is not received within a heating chamber, but rather the workpiece (7) is heated within a welding area (16) within the container (1) itself.

Claim 8 recites a liner assembly for a SWET box, the liner assembly including “an enclosure configured to be received in a heating chamber of the SWET box, said enclosure comprising a rear wall, a front wall opposite said rear wall, a pair of opposed end walls, and a stepped portion comprising a dividing wall defining a welding chamber therein, said welding chamber sized to receive a component being welded therein”

Joecks does not describe nor suggest a liner assembly for a SWET box as is recited in Claim 8. More specifically, Joecks does not describe nor suggest a liner assembly including an enclosure configured to be **received in a heating chamber** wherein the enclosure includes a **stepped portion** having a dividing wall defining a welding chamber. Rather, in contrast to the present invention, Joecks describes a protective-gas container that includes substantially planar walls, wherein the workpiece is heated within a welding area defined within the

container itself. Accordingly, for at least the reasons set forth above, Claim 8 is submitted to be patentable over Joecks.

Claims 11-14, directly or indirectly, depend from independent Claim 8. When the recitations of Claims 11-14 are considered in combination with the recitation of Claim 8, Applicant submits that dependent Claims 11-14 likewise are patentable over Joecks.

Claim 16 recites a SWET box including “a heating chamber; an enclosure configured to be received in said heating chamber, said enclosure comprising a rear wall, a front wall opposite said rear wall, a pair of opposed end walls, and a stepped portion comprising a dividing wall defining a welding chamber therein, said welding chamber sized to receive a component being welded therein . . .”

Joecks does not describe nor suggest a SWET box including a heating chamber and an enclosure as is recited in Claim 16. More specifically, Joecks does not describe nor suggest a liner assembly including an enclosure configured to be **received in a heating chamber** wherein the enclosure includes a **stepped portion** having a dividing wall defining a welding chamber. Rather, in contrast to the present invention, Joecks describes a protective-gas container that includes substantially planar walls, wherein the workpiece is heated within a welding area defined within the container itself. Accordingly, for at least the reasons set forth above, Claim 16 is submitted to be patentable over Joecks.

Claims 18-19 variously depend from independent Claim 16. When the recitations of Claims 18-19 are considered in combination with the recitation of Claim 16, Applicant submits that dependent Claims 18-19 likewise are patentable over Joecks.

For at least the reasons set forth above, Applicant respectfully requests that the Section 102(b) rejection of Claims 8, 11-14, 16, 18 and 19 be withdrawn.

The rejection of Claims 15 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Joecks in view of Offer et al. (U.S. Patent No. 5,981,897) (“Offer”) is respectfully traversed.

Joecks is described above. Offer describes to a gas diffuser structure for emitting a laminar flow of inert gas at a location inside a weld groove (2). Notably, Offer does not

describe nor suggest a heating chamber, a SWET box, or an enclosure having a stepped portion including a dividing wall.

Claim 15 depends from independent Claim 8 which recites a liner assembly for a SWET box, the liner assembly including “an enclosure configured to be received in a heating chamber of the SWET box, said enclosure comprising a rear wall, a front wall opposite said rear wall, a pair of opposed end walls, and a stepped portion comprising a dividing wall defining a welding chamber therein, said welding chamber sized to receive a component being welded therein”

No combination of Joecks and Offer describes or suggests a liner assembly for a SWET box as is recited in Claim 8. Specifically, no combination of Joecks and Offer describes or suggests a liner assembly including an enclosure configured to be **received in a heating chamber** wherein the enclosure includes a **stepped portion** having a dividing wall defining a welding chamber. Rather, in contrast to the present invention, Joecks describes a protective-gas container that includes substantially planar walls, wherein the workpiece is heated within a welding area defined within the container itself, and Offer merely describes to a gas diffuser structure. Accordingly, for at least the reasons set forth above, Claim 8 is submitted to be patentable over Joecks in view of Offer.

Claim 15 directly depends from independent Claim 8. When the recitation of Claim 15 is considered in combination with the recitation of Claim 8, Applicant submits that dependent Claim 15 likewise is patentable over Joecks in view of Offer.

Claim 16 recites a SWET box including “a heating chamber; an enclosure configured to be received in said heating chamber, said enclosure comprising a rear wall, a front wall opposite said rear wall, a pair of opposed end walls, and a stepped portion comprising a dividing wall defining a welding chamber therein, said welding chamber sized to receive a component being welded therein”

No combination of Joecks and Offer describes or suggests a SWET box including a heating chamber and enclosure as is recited in Claim 16. Specifically, no combination of Joecks and Offer describes or suggests a SWET box including an enclosure configured to be **received in a heating chamber** and including a **stepped portion** having a diving wall defining a welding chamber. Rather, in contrast to the present invention, Joecks describes a

protective-gas container that includes substantially planar walls, wherein the workpiece is heated within a welding area defined within the container itself., and Offer merely describes to a gas diffuser structure. Accordingly, for at least the reasons set forth above, Claim 16 is submitted to be patentable over Joecks in view of Offer.

Claim 20 directly depends from independent Claim 16. When the recitation of Claim 20 is considered in combination with the recitation of Claim 16, Applicant submits that dependent Claim 20 likewise is patentable over Joecks in view of Offer.

Applicant also respectfully submits that the Section 103 rejection of presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to combine Offer with Joecks. More specifically, it is respectfully submitted that a *prima facie* case of obviousness has not been established. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.” In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

[i]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicant’s disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant’s

disclosure. In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown. Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicant requests that the § 103 rejection of Claims 15 and 20 be withdrawn.

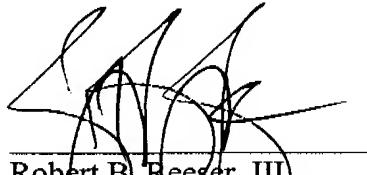
Moreover, if art “teaches away” from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Specifically, Applicant respectfully submits that Joecks teaches away from the present invention, and as such, thus supports the nonobviousness of the present invention. More specifically, Joecks clearly describes a container wherein the component being welded is secured in position within a heating chamber, rather than the enclosure defined within the heating chamber. Offer does not even mention a SWET box or an enclosure configured to be received in a heating chamber of a SWET. As such, the presently pending claims are patentably distinguishable from the cited combination.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103(a) rejection of Claims 15 and 20 be withdrawn.

Claims 9, 10 and 17 have been withdrawn from consideration. However, Claims 9 and 19 directly depend from independent Claim 8, and Claim 17 directly depends from independent Claim 16. Therefore, Claims 9, 10 and 17 are respectfully submitted as patentable over the applied art for at least the reasons discussed above with respect to Claims 8 and 16. Thus, it is respectfully requested that Claims 9 and 10 be rejoined upon allowance of Claim 8, and Claim 17 be rejoined upon allowance of Claim 16.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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